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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,858	11/25/2000	Paul Lapstun	NPP022US	3954

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/721,858	<b>Applicant(s)</b> LAPSTUN ET AL	
	<b>Examiner</b> Saeid Ebrahimi-dehKordy	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 13-21 and 24-25 is/are rejected.
- 7) ☒ Claim(s) 7 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Response to Arguments

### **Response to Arguments**

1. Applicant's arguments filed 4/25/2005 have been fully considered but they are not persuasive. Examiner acknowledges the improper final; However Examiner believes that the rejection still stands with the amended claims 1 and 18. Examiner points out that the combination of prior art applied are sufficient to reject the pending claims. Examiner note, in column 5 lines 41-48 of Perkins et al where the hard copy "printed" with visible or invisible code. And as taught by Hube on column 3 lines 24-29 and on column 4 lines 13-22 where any kind of printer could be used to accomplish this. Therefore examiner believes that the combination of Hube and Perkins et al would in fact make cover the claims.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim1-6,8-9,13,17-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube (U.S. patent 5,243,381) in view of Perkins et al (U.S. patent 5,655,759)

**Regarding claim 1 and 18** Huber discloses: A printer for printing a collated multi-page document when presented with a plurality of manually collated pages (please note column 5 lines 62-67 and column 6 lines 1-8 and column 4 lines 31-35 where In Fig.2 the collator item 58 called manipulation section does the collation of the document) the printer including (a) a code sensor which senses machine-readable codes on the manually collated pages (please note column 7 lines 65-68 and column 8

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lines 1-50) (b) a control unit which uses the machine-readable codes to identify and retrieve previously stored electronic versions of the pages (please note column 3 lines 15-29 where retrieved electronic pages are fetched from the memory) and (c) a print engine which prints the retrieved pages (please note column 3 lines 28-29) However Hube does not disclose: where machine readable codes are substantially invisible to the unaided human eye. On the other hand Perkins et al disclose: where machine readable codes are substantially invisible to the unaided human eye (please note column 5 lines 43-53 where the substrate of collated stock or a disposable copy/print created Via a hard copy or electronic original with visible or invisible bar codes).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Hube's invention according to the teaching of Perkins et al, where Perkins et al in the same filed of endeavor teach the way the electronic pages are coded with visible or invisible bar code to add for the purpose of giving the option of being read by the human eye or in case of invisibility not to be read by the naked human eye.

**Regarding claim 2 and 19** Hube discloses A printer according to claim 1 further including a binder for binding together the printed pages (please note column 5 lines 18-22).

**Regarding claim 3 and 20** Hube discloses: A printer according to claim 1 further including a scanner for copying pages which do not have machine-readable codes on them and which produces electronic versions of the pages (please note column 3 lines 15-22).

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**Regarding claim 4** Hube discloses: A printer according to claim 3 further including a storage medium which stores the electronic versions of the scanned pages (please note column 3 lines 20-30).

**Regarding claim 5** Hube discloses: A printer according to claim 1 further including a hand-held code sensor, which senses machine-readable codes on the manually collated pages (please note column 9 lines 64-67 and column 10 lines 1-20)

**Regarding claim 6** Hube discloses: A printer according to claim 1 or 5 wherein the machine-readable codes on the manually collated pages are represented:  
(a) optically; or (b) electronically; or (c) magnetically; or (d) topographically; or (e) chemically (please note column 3 lines 15-23).

**Regarding claim 8** Hube discloses: A printer according to claim 1 wherein the control unit also controls communications between the printer and one or more peripheral devices (please note Fig.2 column 4 lines 1-12).

**Regarding claim 9**, Hube discloses: A printer according to claim 1 wherein electronic versions of the manually collated pages which are to be printed are retrieved from at least one of the group including: (a) a storage medium contained within a host computer; (b) a server which is accessed over a computer network; (c) a storage medium contained within the printer itself; or (d) any combination of the above (please note Figs.9A and 9B column 7 lines 35-41).

**Regarding claim 13** Hube discloses: A printer according to claim 2 wherein the printer inserts blank pages in the printed document to duplicate blank pages contained within the manually collated pages (please note column 6 lines 1-8).

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**Regarding claim 17**, Hube discloses: A printer according to claim 1 further including a storage medium which stores an electronic version of pages which have been printed (please note 9 lines 48-61).

**Regarding claim 21**, Hube discloses: A method according to claim 18 wherein the step of printing the retrieved pages includes printing machine-readable codes on those pages (please note column 3 lines 19-29).

**Regarding claim 25**, Hube discloses: A method according to claim 18 wherein the printing step includes the sub-step of transmitting the retrieved pages to a remote printer (please note column 3 lines 21-29).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 10-11,14-16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube (U.S. patent 5,243,381) in view of Perkins et al (U.S. patent 5,655,759) and further in view of Delfer et al (U.S. patent 5,754,434)

**Regarding claim 10 and 24** Neither Hube nor Perkins et al disclose: A printer according to claim 1 further including an input device with which a user of the printer controls the format of the printed and collated multi-page document. On the other hand Delfer et al disclose: A printer according to claim 1 further including an input device with

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which a user of the printer controls the format of the printed and collated multi-page document. (please note column 7 lines 62-67 and column 8 lines 1-24).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Hube and Perkins's invention according to the teaching of Delfer et al, where Delfer et al in the same filed of endeavor teach the way the document is being formatted to by user for collation.

**Regarding claim 11**, Delfer et al disclose: A printer according to claim 10 wherein the input device includes a touch sensitive display (please note column 8 lines 10-23).

**Regarding claim 14**, Delfer et al disclose: A printer according to claim 1 wherein instructions from a hand-held code sensor are received and interpreted and a collated multi-page document is produced (please note column 12 lines 42-49).

**Regarding claim 15**, Delfer et al disclose: A printer according to claim 1 further including an interface which transmits instructions for printing a collated multi-page document to a second printer (please note column 7 lines 26-32).

**Regarding claim 16**, Delfer et al discloses: A printer according to claim 15 wherein the instructions are transmitted over a computer network or over a telephone network (please note column 7 lines 61-67).

### **Allowable Subject Matter**

6. Claim 7 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim

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and any intervening claims. As prior art fails to teach the sensor sensing the machine-readable codes on both sides of the manually collated pages.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### **Contact Information**

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (571) 272-7462.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.



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**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
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**Or faxed to:**

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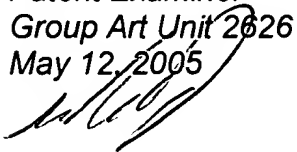
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**Hand delivered responses** should be brought to Knox building on 501 Dulany  
Street, Alexandria, VA.

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2626  
May 12, 2005



  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER